

REMARKS

In the September 8, 2005 Office Action, the Examiner objected to certain informalities in claims 2-3, rejected claim 1 as indefinite, rejected claims 1, 4-8, 11-13 and 17-20 under 35 U.S.C. 102 as being anticipated by U.S. Patent No. 2003/0046304 ("the Peskin reference"), and rejected claims 2-3, 9-10 and 14-16 under 35 U.S.C. 103(a) as being unpatentable over the Peskin reference. To clarify the present invention and overcome the noted informalities, Applicant hereby amends claims 1-3, 9, 12 and 19, and cancels claim 16 without prejudice. Accordingly, claims 1-15 and 17-20 are pending.

A. The Informalities and Indefiniteness Have Been Removed From Claims 1-3

In response to the Examiner's objection to claims 2-3, Applicant respectfully submits that the amended claims have been corrected as suggested by the Examiner, and requests that the objection be reconsidered and withdrawn. Applicant also requests that the indefiniteness rejection of claim 1 be reconsidered and withdrawn in view of the amendment to claim 1 to remove the word "may."

B. Claims 1, 4-8, 11-13 and 17-20 Are Not Anticipated by Peskin

In response to the Examiner's rejection of claims 1, 4-8, 11-13 and 17-20 as being anticipated by the Peskin reference, Applicant respectfully requests reconsideration of the rejection in view of the amendments and remarks presented herein. Among other differences, claim 1's provision of a wireless local area network WLAN device for determining a current location of the mobile computing device is nowhere disclosed or suggested by the Peskin reference. Indeed, the Examiner conceded that Peskin does not disclose a WLAN device by resorting to "Official Notice" for the assertion that "WLAN is well known in the communication art." Office Action, p. 4. And even if WLAN devices are well known in the communication arts, Applicant respectfully submits that the Examiner's conclusion -- that such WLAN devices would be used to obtain location information for use by scheduling facility -- does not automatically follow and is in no way supported by sound technical and scientific reasoning, as required by MPEP § 2144.03(C) (8th ed. Rev. 4, Oct. 2005). On this point, Applicant respectfully traverses the "Official Notice" taken by the Examiner on this point, and requests that the Examiner support the "Official Notice" conclusion with adequate evidence. Based on the foregoing, Applicant respectfully submits that at least claims 1-11 are not anticipated by Peskin.

In addition, the recitation of a “modified” alert in at least claims 1, 18 and 19 is nowhere disclosed or suggested by Peskin’s disclosure of “deactivating” the reminder. On this point, Applicant respectfully submits that the “modified alert” of the present invention is still providing an alert function, whereas Peskin’s “deactivated” alert provides no alert function whatsoever. Based on the foregoing, Applicant respectfully submits that at least claims 1-11 and 18-20 are not anticipated by Peskin.

Finally, claim 12 has been amended to recite the limitations of cancelled claim 16. Accordingly, for purposes of an anticipation analysis, Applicant respectfully submits that claims 12-15 and 17-18 as currently amended are not anticipated by Peskin.

For the reasons set forth above, Applicant respectfully requests that the anticipation rejection of claims 1, 4-8, 11-13 and 17-20 be withdrawn and the claims be allowed.

C. Claims 2, 3, 9, 10 and 14-15 Are Not Obvious Over Peskin

Applicant also requests reconsideration of the rejection of claims 2, 3, 9, 10 and 14-15 as being obvious over Peskin. Applicant respectfully submits that each obviousness rejection is based on conclusory assertions about the prior art that are either unsupported or directly contradicted by the Peskin reference. For example, after asserting that “WLAN is well known in the communication art,” the Examiner takes “Official Notice that WLAN device for obtaining location information is known in the art” in rejecting claims 2-3. As explained above, even if WLAN devices are well known in the communication arts, Applicant respectfully submits that the Examiner’s conclusion – that such WLAN devices would be used to obtain location information for use by scheduling facility – does not automatically follow and is in no way supported by sound technical and scientific reasoning, as required by MPEP § 2144.03(C). Accordingly, Applicant has traversed the Examiner’s “Official Notice” assertion.

With respect to the rejection of claims 10 and 14-15, the Examiner asserts without support that “since, cellular communication is a network communication, therefore, it would have been obvious of one having ordinary skill in the art at the time of the claimed invention to recognize that cellular communication technology is transmitting through a cellular network.” Office Action, p. 5. For such a modification of the Peskin reference to support the rejection, there must be some implicit or explicit reason, suggestion or motivation from the Peskin reference for a person of ordinary skill (having no knowledge of the claimed invention) to modify the Peskin reference as proposed, but the Examiner has pointed to no such evidence.

See, MPEP, Section 2143.01 ("THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION").

Finally, the rejection of claims 9 and 16 (now incorporated in claim 12) appears to be predicated on a mistaken understanding of the Peskin disclosure that the Examiner uses to reach conclusions that directly contradict the teaching of Peskin. As a preliminary matter, the Examiner asserts that Peskin discloses a telecommunication device that automatically places a phone call to a phone number involved in the appointment, citing paragraph 30 of the Peskin reference. Office Action, p. 5. Applicant respectfully submits that the cited passage does not mention anything about a telecommunication device being used to automatically place a phone call, but instead seems to be describing a conventional alert functionality which is subsequently described as being "deactivated," though never in response to a scheduled phone call being made. Indeed, the Examiner appears to admit as much with the statement that "Peskin does not specifically disclose that the reminder alert is modified or (suppressed) if the predetermined phone number has nor has not been called." However, the Examiner then reverses Peskin's teaching to conclude that it would have been obvious to modify an alert if a phone call is placed. Applicant is not able to reconcile the Examiner's admission with his conclusion, and respectfully submits that the Examiner has not made the requisite *prima facie* showing of obviousness since the Office Action contains no reference to any suggestion or motivation in the Peskin reference or in the knowledge generally available to one of ordinary skill in the art, to modify the Peskin teaching as proposed. See, MPEP, Section 2143 (8th ed. Rev. 2, May 2004); *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure).

When the Office Action relies on an express or implicit showing of a motivation or suggestion to modify or combine references, the Office Action must provide particular findings related thereto. *In re Dembiczak*, 50 USPQ2d at 1617. Applicant respectfully submits that the broad conclusory statements at pages 4-5 of the Office Action do not provide the requisite "evidence." *Id.* Thus, the Office Action must include particular *factual findings* that support an assertion that a skilled artisan would have modified the express disclosure of the Peskin reference to add the missing features to develop the invention recited by claims 2, 3, 9, 10 and 14-15. See *In re Kotzab*, 55 USPQ2d 1313, 1317. Applicant is unable to discern the requisite

factual basis in the Peskin reference or the Office Action for arriving at the claimed invention. Indeed, the Peskin disclosure identified by the Examiner would have resulted in having an alert deactivated and turned off, instead of issuing a modified alert (as recited in claim 9), and no where discloses hardware that detects when a scheduled call has already taken place (as originally recited in claim 16, now claim 12). A reference that teaches away from the invention does not make the invention obvious, and instead rebuts any prima facie case of obviousness. MPEP § 2144.05 (III).

In the absence of any motivation or suggestion from the prior art to modify the Peskin reference, it appears that the rejection of claims 2, 3, 9, 10 and 14-15 is based on an improper hindsight-based obviousness analysis. In this regard, it must be recognized that hindsight reconstruction of claims based on disparate aspects of the prior art may not be employed as a valid basis for the rejection of those claims. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983); *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593, 1595-1596 (Fed. Cir. 1987). Furthermore, an obviousness determination requires that the invention *as a whole* would have been obvious to a person having ordinary skill in the art. *Connell v. Sears Roebuck & Co.*, 220 USPQ 193 (Fed. Cir. 1983).

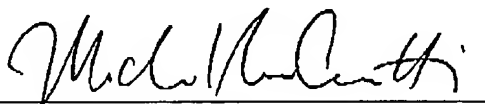
Even if the Peskin reference was modified as proposed by the Examiner, Applicant respectfully submits that there is no disclosure, teaching or suggestion of providing a modified alert in response to a location condition being met, as recited variously in claims 1-11 and 18-20. Indeed, the Peskin reference expressly teaches away from the present invention with its teaching to "deactivate" the alert. Peskin, paragraph 86 and Figs. 7-8. As for the remaining pending claims 14 and 15 that were rejected under 35 U.S.C. § 103, Applicant submits that the rejection has been overcome in view of the amendments to the base claim 12 that recite limitations conceded by the Examiner to be missing from Peskin. Accordingly, Applicant respectfully requests that the obviousness rejection of claims 2, 3, 9, 10 and 14-15 be withdrawn and the claims be allowed.

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and Applicant respectfully requests that the rejections of pending claims 1-15 and 17-20 withdrawn and that a Notice of Allowance be issued. If there are any remaining issues that might be resolved through a telephonic interview, Applicant's undersigned representative would welcome an opportunity to discuss such issues with the Examiner.

CONCLUSION

In view of the amendments and remarks set forth herein, Applicant respectfully submits that all pending claims are in condition for allowance. Accordingly, Applicant requests that a Notice of Allowance be issued. Nonetheless, should any issues remain that might be subject to resolution through a telephone interview, the Examiner is requested to telephone the undersigned at 512-338-9100.

I hereby certify that this correspondence is being transmitted via facsimile to the USPTO on December 7, 2005.



Attorney for Applicant

Respectfully submitted,



Michael Rocco Cannatti
Attorney for Applicant
Reg. No. 34,791